



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/913,745

12/10/2001

Kathleen R. McKeown

A32313-PCT

3754

21003

7590

07/02/2007

BAKER BOTTS L.L.P.

30 ROCKEFELLER PLAZA

44TH FLOOR

NEW YORK, NY 10112-4498

EXAMINER

CORRIELUS, JEAN M

ART UNIT

PAPER NUMBER

2162

MAIL DATE

DELIVERY MODE

07/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/913,745	Applicant(s) MCKEOWN ET AL.	
	Examiner Jean M. Corrielus	Art Unit 2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the request for consideration filed on May 25, 2007, in which claims 1-22 are presented for further examination.

Response to Arguments

2. Applicant's arguments filed on May 25, 2007 have been fully considered but they are not persuasive. (See examiner notes).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 5-8, 12-16 and 20-22 as best understood by examiner are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakao US Patent no. 6,205,456 and Razin et al., (hereinafter "Razin") US Patent no. 6,098,034.

As to claim 1, Razin discloses the claimed "extracting phrases having focus elements from the plurality of documents" as extracting phrases in a document to automatically create a list of extracted phrases (col.2, lines 45-56; col.30, lines 53-54); "performing phrase intersection analysis on the extracted phrases to generate a phrase intersection table" determining which phrases that are identical (col.2, lines 56-64); "performing temporal processing on the phrases in the phrase intersection table" (col.3, lines 24-30, lines 46-58; col.4, lines 4-17); and "performing

sentence generation using the phrases in the phrase intersection table” constructing sentence from the determination of standard phrases (col.3, lines 35-38). However, Razin does not explicitly disclose the use of generating a summary of the plurality of related documents. On the other hand, Nakao discloses a system for generating a summary of the plurality of related documents available in computer readable media by performing sentence generation using the phrases in the phrase intersection table (col.5, lines 64-67; col.6, lines 14-17); and “extracting phrases having focus elements from the plurality of documents” extracting a phrase in the document based on the condition of the pattern or the extracting sentences (col. Lines 57-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of the cited references, wherein the master phrase finding phrase, provided therein (see Razin’s fig. 2) would incorporate the use of generating a summary of the plurality of related documents. One having ordinary skill in the art at would found it motivated to utilize such a combination in order to ensure the syntactic coherence of the document.

5. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakao US Patent no.6,205,456 and McGreevy; Michael US Patent no. 6,823,333

As to claim 1, discloses the claimed “extracting phrases having focus elements from the plurality of documents” (extracting a portion (phrase) related to the author focused information from a plurality of documents to be summarized; col.8, lines 22-24; col.10, lines 40-56); “performing phrase intersection analysis on the extracted phrases to generate a phrase intersection table” (determination conditions of document elements from which the author focused information is extracted by comparing with the document structure information; col.10, lines 62-65; col.12,

Art Unit: 2162

lines 57-61 to generate a focused information list, focused concept list); and “generating a summary of the plurality of related documents available in computer readable media by performing sentence generation” (generating a summary of the plurality of documents; col.12, lines 36-65). However, does not explicitly perform a sentence generation and temporal processing using phrases in the phrase intersection table. However, McGreevy; Michael performs “a sentence generation and a temporal processing using phrases in the phrase intersection table” as a paraphrasing rules that detect similarities in non-identical phrases in the documents; and a intersection model (col.20, lines 13-25; 35-41); relationship among the phrases. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teaching of the cited references, wherein the document summarization of Nakao would incorporate the use of paragraphing rules as discloses by McGreevy; Michael for the purpose of automatically generating a summary appropriate to the documents and providing a more concise description of the documents summary, thereby increasing the efficiency of the document summarization system of Nakao.

As to claim 2, McGreevy, Michael discloses substantially the invention as claimed. In addition, applying paraphrasing rules to non-identical root nodes to determine if non-identical node is equivalent (col.20, lines 13-25; 35-41).

As to claim 3, Nakao discloses “a tree structure” a class definition, a dependence-defined document structure information (see fig.4, col.1, lines 35-42).

Art Unit: 2162

As to claim 4, Nakao discloses a change in grammatical features, omission of an empty head, transformation of one part of speech to another, and semantically related word “ (col.14, lines 55-58; col.15, lines 4-13).

As to claims 5-7, Nakao substitutes data certain references for ambiguous temporal references; a language generation engine and operating the language engine” using the natural language to substitute ambiguous reference (col.15, lines 53-64).

As to claims 8-15:

Claims 8-15 are system claims for performing the method of claims 1-7 above. In addition, Nakao discloses “a storage for storing document in the collection” (col.9, lines 53-56); “a lexical database” (col.19, lines 40-51); “a processing subsystem, the processing subsystem being operatively coupled to the storage device and the lexical database, the processing subsystem being programmed to access the plurality of related documents in the storage device and generate a summary” (col.19, lines 40-51).

As to claims 16-22

Claims 16-22 are computer readable media comprises instructions for executing the method of claims 1-7 above.

Remark

6. Applicant asserted that one of ordinary skill in the art would not have the motivation to combine and there is no identifiable reason that would prompt someone to combine the elements of Nakao and Razin. Moreover, even if such a combination was properly made, the combination of Nakao and Razin does not disclose all elements recited in claim 1. The examiner has carefully considered the subject matter as argued by applicant, the rejections advanced by the examiner, and the evidence of obviousness relied upon by examiner as support for the rejections. In rejecting the claims under 35 U.S.C. 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason has stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. The examiner's position with respect to the assertion above is that Razin discloses a system that identifies phrases of a document to create a preliminary list of standard phrases; filters the preliminary list of standard phrases to create a final list of standard phrases; identifies candidate phrases of the document which are similar to the standard phrases; confirms whether a candidate phrase of the document is sufficiently proximate to the standard phrase to constitute an approximate phrase; and computes a phrase substitution to determine the appropriate conformation of the standard phrase to the approximate phrase or the approximate phrase to the standard. On the other hands, Nakao discloses a system for generating a summary of the plurality of related documents

Art Unit: 2162

available in computer readable media by performing sentence generation using the phrases in the phrase intersection table (col.5, lines 64-67; col.6, lines 14-17); and “extracting phrases having focus elements from the plurality of documents” extracting a phrase in the document based on the condition of the pattern or the extracting sentences (col. Lines 57-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of the cited references, wherein the master phrase finding phrase, provided therein (see Razin’s fig. 2) would incorporate the use of generating a summary of the plurality of related documents. One having ordinary skill in the art at would found it motivated to utilize such a combination in order to ensure the syntactic coherence of the document.

Furthermore, The examiner disagrees with the precedent assertion. Appellant appears to misinterpret the guidance given under MPEP 2142. In particular, references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969.

MPEP 2143 states:

“To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the

Art Unit: 2162

prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).”

As set forth in the office actions mailed February 6, 2007, the suggestion to modify Razin and Nakao suggested by both and knowledge of the ordinary skilled artisan at the time the invention was made. The Court, In re Fritch, stated “the examiner can satisfy the above mentioned assertion only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”. In re fine, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (Citing In re Lalu, 747, F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Specifically, Nakao teaches a system for generating a summary of the plurality of related documents available in computer readable media by performing sentence generation using the phrases in the phrase intersection table; and extracting a phrase in the document based on the condition of the pattern or the extracting sentences. One having ordinary skill in the art at would found it motivated to utilize such a combination in order to ensure the syntactic coherence of the document.

Moreover, the issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions In re Delisle 406 Fed 1326, 160 USPQ 806; In re Kell, Terry and Davies 208 USPQ 871; and In re Fine, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1596, 1598 (Fed. Cir. 1988) (Citing In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined In re Lamberti et al., 192 USPQ 278 (CCPA) that:

- (a) Obviousness does not require absolute predictability;

Art Unit: 2162

- (b) Non-preferred embodiments of prior art must also be considered; and
- (c) The question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement, that which is disclosed therein.

Hence, the examiner has clearly established the first criteria of the *prima facie* case of obviousness.

Secondly, the examiner has established that there is a reasonable expectation of success of the Razin/Nakao combination. In the last office action, the examiner went through the claims phrase by phrase and referred to the prior art column and line number as to where he has drawn the correspondences between appellant's claims phrases and prior art. Both Razin and Nakao are directed to the same field of endeavor. Hence, clearly the systems are compatible and would render a combination system successful.

Finally, as set forth in the final office action, the suggestion to make the claimed combination and the reasonable expectation of success are both found in Razin and Nakao.

7. Applicant asserted that nowhere does Razin, Nakao and McGreevy disclose or suggest performing temporal processing on the phrases in the phrase intersection table; wherein the phrases in the phrase intersection table have been subject to temporal processing as recited in claim 1. The examiner disagrees with the precedent assertion. However, when read and analyzed in light of the specification, the invention as claimed does not support Applicants' assertions. The

Art Unit: 2162

claims do not capture the essence of the invention as argued by applicant. The aforementioned assertions, wherein the step of performing temporal processing on the phrases in the phrase intersection table; wherein the phrases in the phrase intersection table have been subject to temporal processing fails to disclose by Razin; Nakao and McGreevy with regard to the invention of claim 1, was unsupported by objective factual evidence and was not found to be substantial evidentiary value. In the last office action, the examiner went through the claims phrase by phrase and referred to the prior art column and line number as to where he has drawn the correspondences between applicants' claimed invention phrases and prior art. By failing to address these correspondences, applicants have failed to rebut the examiner's prima facie case of obviousness uses for a different purpose, which does not alter the conclusion that its use in a prior art device would be prima facie obviousness from the purpose disclosed in the reference. *It is unreasonable for the applicant can not state that the Razin; Nakao and McGreevy references do no disclose the above claimed features without providing substantial evidence how the portion cited in the references differ from the invention as claimed. There is nowhere in the applicant's remark the step of performing temporal processing on the phrases in the phrase interception table is different from the lines correspondence cited by the examiner. Without any clarification, one having ordinary skill in the art would not know what a temporal process and phrase intersection table are; and how the phrases in the phrase intersection table is subject to temporal processing.* Consequently, Applicants have failed to successfully rebut the rejection of the cited claims. Instead the applicant has provided numerous court decisions to backup his assertion. It has been held that Applicants bear the burden of explaining why the evidence on which the Examiner relies is insufficient to establish a prima facie case or

Art Unit: 2162

demonstrating that Applicants have provided evidence, which rebuts the prima facie case. See *In re Rouffet*, 149 F.3d 1350, 1355 47 USPQ2d 1453, 1455 (Fed. Cir. 1998). The applicants have not provided substantial evidence as to how the phrases in the phrase intersection table is subject to temporal processing and how a temporal processing and phrase interception table is different from the cited prior art provided by the examiner. The phrases in the phrase intersection table that is subject to temporal processing; temporal processing and phrase interception table are not defined by the claims. Applicants are reminded that the examiner is entitled to the broadest reasonable interpretation of the claims. The Applicants always have the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In *re Prater* 162 USPQ 541, 550-51 (CCPA 1969).

The Applicant has provided the opportunity once again to clarify the above-mentioned limitation, and better yet to amend the claims to define the above claimed features to reduce the possibility that the claim, once issued, will not be interpreted more broadly than is justified. Applicant is advised to make such clarification or amendment in order to advance the prosecution of the Patent Application.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO


Art Unit: 2162

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M. Corrielus whose telephone number is (571) 272-4032. The examiner can normally be reached on 10 hours shift.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jean M Corrielus
Primary Examiner
Art Unit 2162